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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,106	07/11/2001	Haile Tecle	5940-01-SMH	7962

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01/23/2003

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,106

Applicant(s)

TECLE ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 30-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 23-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of Claims

Claims 1-50 are pending in the application. Claims 30-50, are withdrawn from consideration by the Examiner under 37 C.F.R. 1.142 (b) as directed to non-elected subject matter.

Response to Election/Restriction

Applicant's election without traverse of Group III, which includes claims 1-29 in paper No.5 filed on December 2nd, 2002, is acknowledged. The requirement for restriction in Paper No. 4 is deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey, DM (US Pat No. 4,510,139). Applicant claims a pharmaceutically active diaryl amines, and methods of making and using them. Bailey '139 also disclose many substituted aminobenzamides compounds, one of which anticipates the instantly claimed compound wherein W is OR₁, R₁ is H, each of R₄, R₅ and R₆ is independently H, R₁₀ and R₁₁ are H, J is OR_C, and R_C is alkyl (See Example 1, column 5, lines 27-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey, DM (US Pat No. 4,510,139). Applicant claims a pharmaceutically active diaryl amines, and methods of making and using them.

Determination of the scope and content of the prior art (MPEP §2141.01)

Bailey, '139 teach a generic compound and composition of formula (1) having various substitutions in R, R', R'' and Z that are useful as inhibitors of lipoygenase activity.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds taught by Bailey, '139 are of applicant's compounds. The difference between the claimed compounds and that of the reference herein lie in the selection of different R groups in carbocyclic ring, such as R₄, R₅ and R₆ which are F[•] or Br in the claimed compounds instead of Chloro in the prior art (example 17, column 9). In *Ex parte Wiseman*, 98 USPQ 277 (1953), it was held that compounds are rejected over prior art when the difference between the claimed compounds and the compounds of the prior art is two fluorine atoms versus chlorine atoms. The basis of this reasoning is that fluorine and chlorine are both halogen elements from the seventh group of the periodic system and the claimed compound is thus an analogue or an isologue of that disclosed in the prior art. The compounds are expected to possess similar properties differing only in degree. The disclosure of Bailey, '139 teach several combinations

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that would easily place Applicants invention in possession of the public at the time of Applicants invention was filed.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention was made since Bailey, '139 teach compounds which are homologs to the claimed compounds. The claimed compounds are so closely related structurally to the homologous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. The motivation to make the claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979). In looking at the instant claimed compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

Claim Objections

Claims 1, 10, 18 and 25-28 are objected to for containing non-elected subject matter (such as morpholinyl, pyrazinyl, piperazinyl, pyrrolidinyl, or piperadinyl etc. in claim 1, line 25, page 44). The claims must be amended to exclude non-elected subject matter and within the limit of the elected compound and all the dependent claims also, must be amended to satisfy the restriction requirement. Claims 23, 24 and 29 are objected to as being dependent upon a rejected base claim 1. The elected subject matter of the claims should be rewritten in independent form including all of the limitations of the base claim and any intervening claims.



Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The Examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

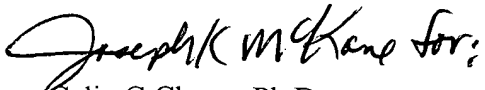
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

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January 21, 2003


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